## REMARKS

In the Office Action, claims 1-19 were pending, and claims 1-29 were rejected. In their present form, claims 1-19 should be allowable. Please consider the following remarks.

### I. Rejections under 35 U.S.C. 103

#### A. Rejection over US. Patent No. 6,207,625 ("Organo") in view of US Patent No. 3,898,168 ("Brehm") and US Patent No. 3,876,550 ("Holubec")

In an Office Action mailed March 23, 2006 at page 2, number 2, the Examiner stated that Organo fails to disclose the use of specific rust inhibitors like the ones presently claimed. The Examiner further stated that it would have been obvious to one of ordinary skill in the art to utilize the anti-rust agents taught in Brehm and Holubec in Organo to produce the present invention. Applicants respectfully traverse this rejection.

##### 1. The Present Invention

The present invention as recited in claim 1 is a lubricating oil composition suitable for use in a four stroke marine engine which comprises an oil of lubricating viscosity containing an admixture of (a) 1 - 3.75 wt.% of an ashless dispersant; (b)a metal detergent; (c)an oil soluble molybdenum compound in an amount sufficient to provide 15 - 1,000 ppm molybdenum in the composition; (d) a zinc dialkyl dithiophosphate in an amount sufficient to provide at least 1,200 ppm phosphorus in the composition; (e) a rust inhibitor system comprising (i) as a first rust inhibitor, an ethoxylated $C_4$-$C_{18}$ alkyl phenol having 2-10 moles of ethylene oxide per mole in combination with a second rust inhibitor selected from the group consisting of (ii) a glycerol ester of a $C_8$-$C_{22}$ fatty acid, (iii) a half ester of a $C_8$-$C_{22}$ alkyl or alkenyl succinic acid and a $C_2$-$C_4$ alkylene glycol and (iv) a $C_8$-$C_{22}$ alkyl or alkenyl succinic acid or anhydride

## 2. The Cited References

### a. Organo

Organo discloses a lubricant oil composition, comprising a base oil composed of a mineral and/or synthetic oil incorporated with at least two types of additives (A) and (B) described below, characterized by being used for diesel engines operating with large quantities of soot in their oil, in particular those equipped with an exhaust gas recirculation (EGR) system: (A) sulfurized oxymolybdenum dithiocarbamate at 0.03 to 0.50 wt % as Mo, based on the whole composition, and (B) zinc dialkyl dithiophosphate at 0.04 to 0.50 wt % as P, also based on the whole composition.

### b. Brehm

Brehm discloses a crankcase lubricant oil containing high based magnesium sulfonate and zinc dialkyl dithiophosphate antioxidant-antiwear addition agents. Brehm teaches anti-rust function can be provided by the use of a small amount of polyether addition agent, increasing amount of zinc dialkyldithiophosphate addition agent and decreased amount of higher based magnesium salt of alkyl-substituted benzenesulfonic acid.

### c. Holubec

Holubec discloses lubricant compositions comprising an additive combination comprising an alkylene dithiocarbamate and an aliphatic hydrocarbon-substituted succinic acid or certain derivatives thereof. Holubec teaches an anti-rust component comprising one or more rust inhibitors selected from the group consisting of aliphatic hydrocarbon-substituted succinic acids, aliphatic hydrocarbon-substituted succinic anhydrides and esterified reaction products obtained by the partial esterification of the aliphatic hydrocarbon-substituted acids or their anhydrides with at least one alkylene oxide or alkylene glycol. The partially esterified reaction product is prepared by the esterification of from about 0.1 mole to about 1.0 mole of the alkylene oxide or the alkylene glycol per mole of the aliphatic hydrocarbon-substituted succinic acid or anhydride.

### 3. Traversal of the Rejection

For a proper rejection under Section 103, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck,* 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The present invention as recited in independent claim 1 is a lubricating oil composition comprising a rust inhibitor system comprising (i) as a first rust inhibitor, an ethoxylated $C_4$-$C_{18}$ alkyl phenol having 2-10 moles of ethylene oxide per mole in combination with a second rust inhibitor selected from the group consisting of (ii) a glycerol ester of a $C_8$-$C_{22}$ fatty acid, (iii) a half ester of a $C_8$-$C_{22}$ alkyl or alkenyl succinic acid and a $C_2$-$C_4$ alkylene glycol and (iv) a $C_8$-$C_{22}$ alkyl or alkenyl succinic acid or anhydride. It is a two component system. It has a first rust inhibitor and a second rust inhibitor. None of the cited references, either alone or in combination, teach or suggest the **two** component rust inhibitor system of the lubricating oil composition recited in claim 1.

In contrast to the present invention as recited in claim 1, Organo does not teach or suggest the rust inhibitor system recited in the present invention. The Examiner explicitly stated such in the Office Action. The Examiner goes on to allege the rust inhibitor system of the present invention is taught by Brehm and Holubec. The Examiner's allegation is not correct.

Brehm teaches anti-rust function can be provided by use of a small amount of polyether addition agent, increasing amount of zinc dialkyldithiophosphate addition agent and decreased amount of higher based magnesium salt of alkyl-substituted benzenesulfonic acidone. Therefore, Brehm teaches one part of the two component rust inhibitor system as recited in claim 1 (i.e., the second rust inhibitor which can be selected

from the group consisting of a glycerol ester of a $C_8$-$C_{22}$ fatty acid; a half ester of a $C_8$-$C_{22}$ alkyl or alkenyl succinic acid and a $C_2$-$C_4$ alkylene glycol; and a $C_8$-$C_{22}$ alkyl or alkenyl succinic acid or anhydride). However, Brehm does not teach the other part (i.e., the first inhibitor) of the recited rust inhibitor system.

As stated above, the rust inhibitor system recited in claim 1 has two components. One of the components, the first rust inhibitor, comprises an ethoxylated $C_4$-$C_{18}$ alkyl phenol having 2-10 moles of ethylene oxide per mole. Brehm does not teach this component. The combination of polyether addition agent, increasing amount of zinc dialkyldithiophosphate addition agent and decreased amount of higher based magnesium salt of alkyl-substituted benzenesulfonic acidone as taught by Brehm does not encompass the first rust inhibitor of the present invention. Because the first rust inhibitor of the present invention is not taught by Brehm, Brehm cannot teach the two component rust inhibitor system as recited in claim 1 which is a combination of the first rust inhibitor and the second rust inhibitor. Therefore, a combination of Organo and Brehm does not teach or suggest the lubricating oil composition comprising a rust inhibitor made up of (i) as a first rust inhibitor, an ethoxylated $C_4$-$C_{18}$ alkyl phenol having 2-10 moles of ethylene oxide per mole in combination with a second rust inhibitor selected from the group consisting of (ii) a glycerol ester of a $C_8$-$C_{22}$ fatty acid, (iii) a half ester of a $C_8$-$C_{22}$ alkyl or alkenyl succinic acid and a $C_2$-$C_4$ alkylene glycol and (iv) a $C_8$-$C_{22}$ alkyl or alkenyl succinic acid or anhydride as recited in claim 1.

Holubec teaches an anti-rust component comprising one or more rust inhibitors selected from the group consisting of aliphatic hydrocarbon-substituted succinic acids, aliphatic hydrocarbon-substituted succinic anhydrides and esterified reaction products obtained by the partial esterification of the aliphatic hydrocarbon-substituted acids or their anhydrides with at least one alkylene oxide or alkylene glycol. Similarly to what is stated above, Holubec teaches one part of the two component rust inhibitor system recited in claim 1 (i.e., the second rust inhibitor) but not the other part (i.e., first rust inhibitor) of the recited rust inhibitor system. Because the first rust inhibitor of the present invention is not taught by Holubec, Holubec cannot teach the two component rust inhibitor system as recited in claim 1 which is a combination of the first rust inhibitor and the second rust inhibitor. Therefore, the combination of Organo and Holubec does not teach or suggest

the lubricating oil composition comprising the two component rust inhibitor system recited in claim 1.

For the reasons stated above, Organo, Brehm and Holubec, either alone or in combination, do not teach or suggest all the claim limitations in claim 1 of the present invention as required for a proper rejection under Section 103. Specifically, the references do not teach or suggest a rust inhibitor system comprising a first rust inhibitor and a second rust inhibitor as recited in claim 1. As a result, Applicants respectfully request that the Examiner withdraw the rejection of claim 1 over Organo in view of Brehm and Holubec.

Claims 2-19, directly or indirectly, depend from claim 1of the present invention and recite the invention in varying scope. For the reasons discussed above, Organo, Brehm and Holubec, either alone or in combination, do not teach or suggest the lubricating oil composition comprising a rust inhibitor made up of (i) as a first rust inhibitor, an ethoxylated $C_4$-$C_{18}$ alkyl phenol having 2-10 moles of ethylene oxide per mole in combination with a second rust inhibitor selected from the group consisting of (ii) a glycerol ester of a $C_8$-$C_{22}$ fatty acid, (iii) a half ester of a $C_8$-$C_{22}$ alkyl or alkenyl succinic acid and a $C_2$-$C_4$ alkylene glycol and (iv) a $C_8$-$C_{22}$ alkyl or alkenyl succinic acid or anhydride as recited in claim 1 and in varying scope by claims 2-19. As a result, Applicants respectfully request that the Examiner withdraw the rejection of claims 2-19 over Organo in view of Brehm and Holubec.

**B. Rejection over US Patent No. 6,444,624 ("Walker") in view of Brehm and Holubec**

In the Office Action of March 23, 2006 at page 3, number 3, claims 1-9 and 11-19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Walker in view of Brehm and Holubec. The Examiner stated that Walker fails to disclose the use of specific rust inhibitors like the ones presently claimed. The Examiner further stated that it would have been obvious to one of ordinary skill in the art to utilize the anti-rust agents taught in Brehm and Holubec in Walker to produce the present invention. Applicants respectfully traverse this rejection.

### 1. Walker

Walker discloses an SAE OW-30 or 5W-30 or 5W-20 lubricant having a Noack volatility of less than 15 and a chlorine content of less than 100 ppm. The lubricant comprises a basestock containing from 0 to less than 10% Group I and/or Group II basestocks, a molybdenum additive providing not greater than 1000 ppm of molybdenum to the lubricant, a calcium detergent providing 10 or greater mmoles of surfactant per kilogram of lubricant, one or more other additives, and a viscosity modifier.

### 2. Traversal of the Rejection

The rule for a proper rejection under Section 103 is shown above. The present invention as recited in independent claim 1 is a lubricating oil composition comprising a rust inhibitor system comprising (i) as a first rust inhibitor, an ethoxylated $C_4$-$C_{18}$ alkyl phenol having 2-10 moles of ethylene oxide per mole in combination with a second rust inhibitor selected from the group consisting of (ii) a glycerol ester of a $C_8$-$C_{22}$ fatty acid, (iii) a half ester of a $C_8$-$C_{22}$ alkyl or alkenyl succinic acid and a $C_2$-$C_4$ alkylene glycol and (iv) a $C_8$-$C_{22}$ alkyl or alkenyl succinic acid or anhydride. None of the cited references, either alone or in combination, teach or suggest the two component rust inhibitor system of the lubricating oil composition recited in claim 1.

In contrast to the present invention as recited in claim 1, Walker does not teach the two component rust inhibitor system recited in the present invention. The Examiner explicitly states such in the Office Action. The Examiner goes on to allege the rust inhibitor system of the present invention is taught by Brehm and Holubec. The Examiner's allegation is not correct.

For the reasons discussed above, neither Brehm or Holubec teach a required part (i.e., first inhibitor system) of the recited two component rust inhibitor system. Because the first rust inhibitor of the present invention is not taught by Brehm or Holubec, neither Brehm nor Holubec can teach the two component rust inhibitor system recited in claim 1 which is a combination of the first rust inhibitor and the second rust inhibitor. Therefore, Walker, Brehm and Holubec, either alone or in combination, do not teach or suggest the lubricating oil composition comprising a rust inhibitor made up of (i) as a first rust

inhibitor, an ethoxylated $C_4$-$C_{18}$ alkyl phenol having 2-10 moles of ethylene oxide per mole in combination with a second rust inhibitor selected from the group consisting of (ii) a glycerol ester of a $C_8$-$C_{22}$ fatty acid, (iii) a half ester of a $C_8$-$C_{22}$ alkyl or alkenyl succinic acid and a $C_2$-$C_4$ alkylene glycol and (iv) a $C_8$-$C_{22}$ alkyl or alkenyl succinic acid or anhydride as recited in claim 1. Applicants respectfully request that the Examiner withdraw the rejection of claim 1 over Walker in view of Brehm and Holubec.

Claims 2-9 and 11-19, directly or indirectly, depend from claim 1of the present invention and recite the invention in varying scope. For the reasons discussed above, Walker, Brehm and Holubec, either alone or in combination, do not teach or suggest the lubricating oil composition comprising a rust inhibitor made up of (i) as a first rust inhibitor, an ethoxylated $C_4$-$C_{18}$ alkyl phenol having 2-10 moles of ethylene oxide per mole in combination with a second rust inhibitor selected from the group consisting of (ii) a glycerol ester of a $C_8$-$C_{22}$ fatty acid, (iii) a half ester of a $C_8$-$C_{22}$ alkyl or alkenyl succinic acid and a $C_2$-$C_4$ alkylene glycol and (iv) a $C_8$-$C_{22}$ alkyl or alkenyl succinic acid or anhydride as recited in claim 1 and in varying scope by claims 2-19. As a result, Applicants respectfully request that the Examiner withdraw the rejection of claims 2-9 and 11-19 over Walker in view of Brehm and Holubec.

### C. Double Patenting Rejection over US Patent No. 6,642,188 alone or in view of Holubec

In the Office Action mailed March 23, 2006 at page 5, number 4, claims 1-19 were rejected on the ground of nonstatutory obvious-type double patenting being unpatentable over claims 1-14 of US Patent No. 6,642,188 alone or in view of Holubec. The Examiner states that it would have been obvious to one of ordinary skill in the art to utilize the disclosed rust inhibitors, including mixtures, in the invention of US Patent No. 6,642. Applicants respectfully traverse this rejection.

The present invention as recited in independent claim 1 is a lubricating oil composition comprising a rust inhibitor system comprising (i) as a first rust inhibitor, an ethoxylated $C_4$-$C_{18}$ alkyl phenol having 2-10 moles of ethylene oxide per mole in combination with a second rust inhibitor selected from the group consisting of (ii) a glycerol ester of a $C_8$-$C_{22}$ fatty acid, (iii) a half ester of a $C_8$-$C_{22}$ alkyl or alkenyl succinic

acid and a $C_2$-$C_4$ alkylene glycol and (iv) a $C_8$-$C_{22}$ alkyl or alkenyl succinic acid or anhydride. **It is a specific two component system.**

In contrast to the present invention, the disclosure concerning the rust inhibitor in US Patent No. 6,642,188 is as follows: an ethoxylated nonylphenol or $C_4$-$C_{18}$ alkyl phenol rust inhibitor containing about 2 to 10, preferably 3 to 5, moles of ethylene oxide per mol. Other suitable rust inhibitors include: fatty acid, alkenyl succinate half ester, fatty acid soap, ester of fatty acid and polyhydric alcohol, ethoxylated amines, fatty acid amine, oxidized paraffin, alkyl polyoxyethylene ether, nonionic polyoxyalkylene polyols and esters thereof, other polyoxyalkylene phenols, anionic alkyl sulfonic acids, metal salts of alkyl naphthalene sulfonic acids such as "NA-SUL 129", available from King Industries, and dialkyl hydrogen phosphites or phosphates. No where in the specification of US Patent No. 6,642,188 is the specific two component rust inhibitor system as recited in claim 1 taught or suggested. Nor would it be obvious to invent such a rust inhibitor system from the following disclosure found in the specification.

As discussed above, Holubec does not teach or suggest the rust inhibitor system recited in claim 1. Holubec teach a required part (i.e., first inhibitor system) of the recited rust inhibitor. Therefore, US Patent No. 6,642,188 and Holubec, either alone or in combination, do not teach or suggest the lubricating oil composition comprising a rust inhibitor made up of (i) as a first rust inhibitor, an ethoxylated $C_4$-$C_{18}$ alkyl phenol having 2-10 moles of ethylene oxide per mole in combination with a second rust inhibitor selected from the group consisting of (ii) a glycerol ester of a $C_8$-$C_{22}$ fatty acid, (iii) a half ester of a $C_8$-$C_{22}$ alkyl or alkenyl succinic acid and a $C_2$-$C_4$ alkylene glycol and (iv) a $C_8$-$C_{22}$ alkyl or alkenyl succinic acid or anhydride as recited in claim 1.

For the reasons discussed above, Applicants respectfully request that the Examiner withdraw the rejection of claim 1 over US Patent No. 6,642,188 in view of Holubec.

Claims 2-19, directly or indirectly, depend from claim 1of the present invention and recite the invention in varying scope. For the reasons discussed above, US Patent No. 6,642,188 and Holubec, either alone or in combination, do not teach or suggest the lubricating oil composition comprising a rust inhibitor made up of (i) as a first rust inhibitor, an ethoxylated $C_4$-$C_{18}$ alkyl phenol having 2-10 moles of ethylene oxide per

mole in combination with a second rust inhibitor selected from the group consisting of (ii) a glycerol ester of a $C_8$-$C_{22}$ fatty acid, (iii) a half ester of a $C_8$-$C_{22}$ alkyl or alkenyl succinic acid and a $C_2$-$C_4$ alkylene glycol and (iv) a $C_8$-$C_{22}$ alkyl or alkenyl succinic acid or anhydride as recited in claim 1 and in varying scope by claims 2-19. As a result, Applicants respectfully request that the Examiner withdraw the rejection of claims 2-19 over US Patent No. 6,642,188 and Holubec.

### D. Rejection over US Patent No. 6,642,188

In the Office Action mailed March 23, 2006, claims 1-19 were rejected under 35 U.S.C. 103 as being obvious over US Patent No. 6,642,188 for the reasons discussed above. Applicants respectfully traverse this rejection.

For the reasons discussed above, US Patent No. 6,642,188 does not teach or suggest the lubricating oil composition comprising a two component rust inhibitor system as recited in claim 1. Applicants respectfully request that the Examiner withdraw the rejection of claim 1 over US Patent No. 6,642,188.

Claims 2-19, directly or indirectly, depend from claim 1of the present invention and recite the invention in varying scope. For the reasons discussed above, US Patent No. 6,642,188 does not teach or suggest the lubricating oil composition comprising a rust inhibitor system made up of (i) as a first rust inhibitor, an ethoxylated $C_4$-$C_{18}$ alkyl phenol having 2-10 moles of ethylene oxide per mole in combination with a second rust inhibitor selected from the group consisting of (ii) a glycerol ester of a $C_8$-$C_{22}$ fatty acid, (iii) a half ester of a $C_8$-$C_{22}$ alkyl or alkenyl succinic acid and a $C_2$-$C_4$ alkylene glycol and (iv) a $C_8$-$C_{22}$ alkyl or alkenyl succinic acid or anhydride as recited in claim 1 and in varying scope by claims 2-19. As a result, Applicants respectfully request that the Examiner withdraw the rejection of claims 2-19 over US Patent No. 6,642,188.

## II. Conclusion

Based upon the foregoing, it is submitted that the invention now claimed is neither anticipated, nor rendered obvious by the prior art of record and that the application is now in condition for allowance. As requested by the Examiner, Applicants have submitted with this correspondence Assignments for both the present invention and

US Patent No. 6,642,188 to prove both inventions were commonly owned at the time of invention. The Applicants therefore request that the application now be passed to issue.

Respectfully submitted,

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